IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

HARVEY S. COVER,
Petitioner,

v.

NATHAN SCHWARTZ, doing business as HYGEIA RESPIRATOR CO.,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

The District Court's memorandum of opinion on this patent is printed at R. 365. The District Court made findings of fact (R. 367) and conclusions of law (R. 368). The opinion of the Circuit Court of Appeals is given at R. 391. So far it is unreported.

Jurisdiction.

The statement of jurisdiction is set forth in the foregoing petition.

Statement of the Case.

The facts have been set forth in the foregoing petition.

Specification of Error.

1. The Circuit Court of Appeals for the Second Circuit erred in holding Claims 1 to 8, inclusive, and 10 of Cover patent No. 2,065,304, invalid for want of invention over the Punton Patent No. 2,019,928, in the face of the fact that invention was not in issue and all the evidence was to the contrary,

> by applying its literal "flash of genius" definition, excluding "the exercise of persistent and intelligent search for improvement," etc., and ignoring the fact that the Supreme Court had used the words "flash of genius" merely as another way of describing what was "beyond the scope of the mechanic skilled in the art," and in the face of conflicting opinions in other circuits to the contrary.

Summary of Argument.

The opinion of the Second Circuit Court of Appeals is in conflict with the opinions of other Circuits, and the reasoning of the opinions in the other Circuits plainly shows that the Second Circuit Court of Appeals has misconstrued the *Cuno* case.

ARGUMENT.

The decisions of the Supreme Court of the United States for over a hundred years interpreted "invention" as meaning "something beyond the skill of the mechanic trained in the art." The Congress has impliedly expressed its satisfaction with such interpretation by failing to amend the statute.

> "If Congress, speaking through its responsible members, had any intention of altering what theretofore had not been questioned, namely, that there was no statutory restraints upon assignment by authors of their renewal rights, it is almost certain that such purpose would have been manifested."
>
> *Fred Fisher Music Co.* v. *Witmark,* Decided by this Court April 5, 1943.

The Supreme Court in using the term "flash of genius" was plainly not changing the previous requisite for invention, and the Circuit Court of Appeals of the Second Circuit in construing "flash of genius" to mean "spontaneous or instantaneous improvement" misinterpreted the meaning of "flash of genius."

The Circuit Court of Appeals for the Second Circuit has announced that it would regard nothing as an invention which was the product of

> "the slow but inevitable progress of an industry merely through trial and error and confer a monopoly upon the exercise of persistent and intelligent search for improvement." *Picard* v. *United Aircraft Corp.,* 128 F. (2d) 632.

The concurring opinion of Judge Frank states that Judge Learned Hand applies the following negative test:

> "* * * Nothing is an invention which is the product of 'the slow but inevitable progress * * * through trial and error' and of 'the exercise of persistent and intelligent search for improvement.'"

The concurring opinion of Judge Frank, also, states:

> "* * * And, in each patent suit, the patentee ought to be required to disclose precisely how he arrived at his new device, in order that the court, advised by its own experts, can tell whether it was merely the result of 'trial and error' and 'the exercise of persistent and intelligent search for improvement,' in which event, according to Judge Hand's formula, the patent would not be valid. * * *"

This is entirely in conflict with the very late opinions in the sixth and seventh circuits.

The Circuit Court of Appeals of the Seventh Circuit, in the case of *Chicago Foundry Co.* v. *Burnside Foundry Co.*, decided January 20, 1943, 56 U. S. P. Q. 283, 132 F. (2d) 812, calls attention to the new phrases used to describe the test of invention and states:

> "* * * The so-called changes in tests and in phrases describing them, have thus far failed to register strongly with us, as helpful in determining the question of invention."

The Circuit Court of Appeals of the Seventh Circuit says that "genius" is a "misappellation" which cannot be "defined satisfactorily or in terms of easy and uniform application." The Court said that such expressions as "flash of genius" are "glibly used, but they are difficult of helpful definition."

The Court further states:

> "* * * But what, may we ask, is gained in certainty or clarity by adopting as a test or a definition of pat-

entable invention or discovery, the 'a flash of genius' test? * * * is it understandable to say that there is patentable novelty if it results from a flash of genius, but not patentable invention if it is the result of long-continued experimentation? *We think not.*

"We are advised and believe that in the field of science nearly all advance is made in laboratories where many experiments are made and discoveries result from the trial and error method.

"We assume inventions of all kinds are desirable. Whether great or small, they are helpful."

The Circuit Court of Appeals of the Seventh Circuit stated that its digression might:

"* * * serve to reaffirm the recognized standards which throughout the past century have been applied by courts, with some degree of safety and satisfaction. * * *"

And, it emphasizes:

"* * * the soundness of the standards which have been applied when considering the validity of patents. * * *"

The Court said:

"* * * these old standards seem more real and are easier of application than for the court to ask itself, was this product born out of a flash of genius? * * *"

The Court stated the word "genius" to be:

"* * * a word to conjure with, elastic in meaning and appealing to the imagination. It may be said to be sufficiently elusive to avoid restriction or limitation of its meaning and yet suggestive of the activity of a super-brain, which only may bring forth inventions. * * *"

The Circuit Court of Appeals of the Seventh Circuit talked of "wrestling" with the word and discussed "flash of genius" as making the test of invention:

> "* * * more baffling in its uncertainty and exclude the larger portion of those whose products have heretofore been understood as the work of an inventor."

The Court assumed "in our efforts to define the work of a genius" that it manifests itself chiefly in capacities:

> "* * * the capacity for taking pains, capacity for observing phenomena, capacity for long and studied experimentation with eyes that see, capacity for long continuous mental concentration with an objective clearly in view, etc."

and found that such a definition of "genius" is:

> "* * * at variance with that suggested by the expression 'flash of genius.' The test of flash of genius' has been applied to curtain the field of patentable discovery and to *eliminate* from the protection of patents, all products (even though they came from the superior mind of genius) which were, nevertheless, the product of prolonged study and step by step advance. * * *"

The sixth circuit is also in conflict with the second Circuit:

In *U. S. Gypsum Co.* v. *Consolidated Expanded Metal Co.*, C. C. A. 6, 130 Fed. (2nd) 888, 892, the court said:

> "* * * This is imperative even though we are unable to go the whole way with Judge Learned Hand in his observation in the *Picard* case, *supra,* if correctly interpreted in the concurring opinion in that case as 'a negative test' by which it is determined that 'nothing is an invention which is * * * progress * * * through trial and error.' We remember that the patent law rewards both invention and discovery and that genius has well been defined as 'an infinite capacity for taking pains.' If the story of Edison's long-continued search for an incandescent lamp filament be true, his genius responds to the definition."

The District Court for the Eastern District of New York expressed disagreement with the Circuit Court of Appeals for the Second Circuit in *Wallace* v. *Woolworth Co.*, 45 F. S. 466, 53 U. S. P. Q. 621, said:

> "Apparently the restricted monopoly of patent rights is not to 'reward the exercise of persistent and intelligent search for improvement.' Such is not deemed to 'reveal the flash of creative genius' specified as requisite in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (51 U. S. P. Q. 272).
>
> "And yet it must be recalled that genius has once been defined as the infinite capacity for taking pains. The approved approach to most unsolved problems is the studious and often plodding one, and no reliable substitute has been suggested, even though a solution thereby accomplished is not judicially deemed to attain to the status of patentable invention. Such is the minimizing lens supplied to a district judge for scrutinizing a patent submitted for adjudication."

The "flash of genius" test should be rejected for an additional reason, because it injects into the statute something not appearing therein, as stated by the Circuit Court of Appeals for the Seventh Circuit in *Chicago Foundry Co.* v. *Burnside Foundry Co.*, 56 U. S. P. Q. 283. The statute does not limit an improvement to the manner in which it is made in order to be an invention. The Federal decisions covering a century contain many to the effect that it is the effect of the accomplishment—novelty appearing, rather than the method of accomplishment, with which judicial inquiry in concerned. * * *

Diamond Rubber Co. v. *Consolidated Tire Co.*, 220 U. S. 428, 1911;

The Barbed Wire Patent, 145 U. S. 275, 1892.

Krementz v. *Cottle Co.*, 148 U. S. 556, 1893;

Webster Loom v. *Higgins*, 105 U. S. 580, 1881;

Eibel Process Co. v. *Minnesota, etc.*, 261 U. S. 45, 1923;

Minerals Separation Co. v. *Hyde*, 242 U. S. 261, 1916.

The questions before the Court are—What is the new product? What advance does it show over those in use or known to the art? Our interest is in the child, not in how or when it was born, or who are its parents. Section 31, Title 35, U. S. C. A.

Nowhere in the statute can be found any words which require, or permit us to inquire into the quality of mind or the activity of the mind of the inventor to determine the patentability of his products or processes. Congress was interested in protecting the product of the mind,—not in whether it came as a flash to the mind, or as a happy thought, or by long painstaking search and experimentation.

CONCLUSION.

We respectfully submit that the Circuit Court of Appeals for the Second Circuit, by its decision and its interpretation of the words "flash of genius" as used in *Cuno Corporation* v. *Automatic Device Corporation*, 314 U. S. 84 has completely misconstrued the rule laid down by this Court in that case, and has in effect repealed Section 4886 (U. S. C., Title 35, Section 31) of the Patent Laws, and has disregarded the explicit provisions of Section 4886 and is in conflict with the opinions in *Chicago Foundry Co.* v. *Burnside Foundry Co.*, 56 U. S. P. Q., 283 (C. C. A. 7); *U. S. Gypsum* v. *Consolidated Expanded Metal Co.*, (C .C. A. 6), 130 F. (2) 888, 892; *Wallace* v. *Woolworth*, (U. S. D. C., E. D. N. Y.), 45 F. S. 466.

To permit this decision to stand would mean that the Circuit Court of Appeals for the Second Circuit would find no invention in any improvement in effect, since the history of invention shows that probably no invention has ever been made by a "flash of genius".

The confusion resulting from the various interpretations given to "flash of genius" and the tremendous public interest involved are manifest. It is therefore respectfully submitted that this case is one calling for the exercise by this Court of its supervisory power by granting a writ of certiorari and thereafter reviewing and reversing the portion of the decision referred to and clarifying the decision in the *Cuno* case.

Most Respectfully submitted,

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April 7, 1943

No. 906

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HARVEY S. COVER,
Petitioner,

v.

NATHAN SCHWARTZ, doing business as Hygeia Respirator Co.,
Respondent.

OBJECTIONS TO WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT, AND ARGUMENTS IN SUPPORT THEREOF

NATHAN SCHWARTZ,
Respondent,
Pro se,
100 West 55th Street,
New York, N. Y.

Dated, New York, April 27, 1943.

APPEAL PRINTING CO., INC., 120 CEDAR ST., NEW YORK, WO 2-3242

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OBJECTIONS TO WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT, AND ARGUMENTS IN SUPPORT THEREOF

To the Honorable Chief Justice of the United States and Associated Justices of the Supreme Court of the United States:

Your respondent, Nathan Schwartz, urges, that a *Writ of Certiorari* to the Circuit Court of Appeals of the Second Circuit, to review that portion of the judgment of that Court entered January 11, 1943, holding Claims 1-8 and 10 of patent No. 2,065,304 to Harvey S. Cover invalid, *be denied.*

Statement and Arguments

1. Respondent opposes a reversal of that portion of the judgment of the Circuit Court of Appeals for the Second Circuit, affirming the judgment of the District

Court of the Southern District of New York, which held Claims 1-8 and 10 of patent No. 2,065,304, dated January 9, 1936 (R. 162), issued to Harvey S. Cover, relating to Respirators, invalid for want of invention. Infringement was not conceded.

2. When the case came to trial in November, 1941, the defendant did not waive any defense, and did not waive the defense of non-invention. Infringement was not conceded. The defendant did state that if there was invention "I showed it on June 22nd in the Patent Office before Cover and therefore I contend that it is my invention."

3. Cover's attorney, Mr. Clarke, admitted that Schwartz was the first to file patent application on the subject matter:

> "The Court: 'I still do not understand whether the Schwartz patent that is mentioned is prior art or not prior art with respect to any of the Cover patents. Perhaps the plaintiff can make some statement on that. Are any of the Schwartz patents earlier than all the Cover patents?' "
>
> "Mr. Clarke: 'Some are and some are not.' " (R. 47 and 48)

Mr. Clarke is petitioner's attorney.

It is submitted that if the Schwartz patent on the subject matter with respect to the Cover patent is earlier than the Cover patent, that Schwartz is in fact the prior inventor.

4. The defendant's attorney stated:

> "Mr. Halle, what we are trying to demonstrate is that Cover is not the first inventor." (R. 37)

The defendant's attorney also said:

> "Mr. Halle: What I am trying to demonstrate is that Punton and Schwartz patents, which they do not admit are prior art, are prior art." (R. 52)

It is therefore obvious that if the defense was demonstrating prior art, they did not concede that there was invention by Cover. The defendant has the right to believe that Punton showed invention or that Schwartz (the respondent herein) disclosed invention (see Punton patent, R. 274-282 and Schwartz patent 2,035,097, R. 292-294). It is on these two patents that the Cover patent 2,065,304 was held invalid. Respondent submits that petitioner herein is unduly ramming a proposition that defendant admits invention, that defendant admits infringement. The defendant stands on his rights and admits nothing that may be of any benefit to the plaintiff (petitioner). If the defendant at any time says that there is or was invention of certain subject matter, such as a flange securing a filter pad or a protrusion spacing a filter pad, that had distinctly been explained to be the invention of the defendant (respondent).

The Circuit Court's opinion makes this point clearer than the defendant (respondent) possibly could and they say:

> "But the idea of a removable filter pad held in place by the flange had already been disclosed in an advertisement of appellee in October, 1935 and appellee has already suggested the corrugation of the base plate (Patent No. 2,035,097, issued March 24, 1936).[1] True the base plate there was of rubber, rather than of metal, as here, but this distinction is of no significance." (R. 392—margin)

1. The said patent application was filed June 22, 1935.

5. Petitioner states that "the Court admitted that it was 'not skilled in the art.' " (R. 38). That was on R. 38, but during the trial the judge became quite familiar with the art. (See R. 135.)

The Court: "That was just a matter of convenience. How do you get any invention out of it?" Petitioner's expert answers: "Well, I do not know as to that." Please note that the Court from here on knows the subject matter as well as the petitioner's expert. (See R. 148.) The Court says: "These two exhibits Dr. Schwartz had in his hands a couple of hours, as I remember it. It is a very simple structure." Therefore at this point the Court realizes that the subject matter is simple.

On page R. 51 the Court says: "This is not such an awfully complicated apparatus but that anybody can see it if he wants to get at the facts." Therefore it did not take the Court much time to familiarize himself with the art to be able to say that the apparatus is simple.

6. On page 8 of Petition, the petitioner states: "The Circuit Court of Appeals, also confessedly unskilled in the art, held the patent invalid". Respondent denies that the Circuit Court of Appeals was confessedly unskilled in the art. As a matter of fact, Judge Learned Hand stated at the hearing that the Court was familiar with the subject matter of respirators, such cases having been heard before. When Judge Frank in his concurring opinion in the *Pickard* case[1] refers to the "haphazard" scientific information of justice, he refers to complicated scientific chemical, mechanical, or electrical problems. However, this apparatus was simple. That was soon discovered and so stated by the trial court, and also a similar statement was soon made by Judge Learned Hand. Respondent noticed

1. *Picard* v. *United Aircraft Corp.*, 128 F. (2nd) 632.

that the three judges of the Circuit Court of Appeals as well as the trial judge very quickly adapted and oriented their mentality to the device. The questions put to both plaintiff and defendant were pertinent.

7. Petitioner argues, page 8 of Petition, that the Circuit Court of Appeals held the patent invalid on no more ground than that the alleged improvement involved "no more than the ordinary skill of the art * * *." As a matter of fact while the trial court and also the Circuit Court of Appeals are firm without any reservations whatever that the improvement over Punton is merely mechanical. Yet the Circuit Court of Appeals states in the margin (R. 392) that "the idea of a removable filter pad held in place by flanges had already been disclosed in an advertisement of appellee in October, 1935. And appellee had already suggested the corrugation of the base plate (patent No. 2,035,097, issued March 24, 1936). True the base plate there was of corrugated rubber, rather than of metal, as here, but this distinction is of no significance." Therefore, while the Punton patent No. 2,019,918 was prior art sufficient to cause the trial court and the Appeal Court to concurrently decide that any alleged improvement claimed is only mechanical skill such as is expected of those skilled in the art, the Appeals Court placed further stress by stating that appellee (respondent herein) has in fact disclosed the mechanical improvement claimed.

It is apparent that even though due to some technical reasons appellee (respondent) was unable to obtain priority before the Court of Customs and Patent Appeals, yet, the disclosures of the respondent are prior, and the plaintiff (petitioner) so admitted (R. 47 and 48).

8. On page 9 of Petition, petitioner says: "In view of the sole reliance upon the *Cuno* case in the matter of

invention, and in view of the *Picard* case, 128 F. (2) 632, we submit that the Circuit Court of Appeals narrowly construed the *Cuno* case to require a literal 'flash of genius' for an invention, * * *." It is submitted that the Circuit Court of Appeals having cited the Punton patent 2,019,918, *supra,* and also cited the Schwartz patent No. 2,035,097, *supra,* did not literally construe "Flash of genius". But had in mind the admonition in the *Cuno* case that more must be done to be entitled to a patent than merely to combine the teaching of two or more inventions or devices. Because they plainly point out that Punton (*supra*) taught the article disclosed by cover and what Punton did not teach Schwartz did teach.

9. On page 12 of Petition, plaintiff states that "A definitive determination of this question is of utmost importance * * *". The Supreme Court has already clarified its position regarding combination or aggregation of claims in patents, in the *William Manufacturing Co.* v. *United Shoe Machinery Co.,* 53 U. S. P. Q. 478, May 25, 1942. (Respondent cannot offhand remember the full name and reference, and has no library reference at present.) It is submitted that other cases beside the *Cuno* case can be cited as authority.

10. Concurrent findings of the Trial Court and of the Circuit Court of Appeals is not disturbed by the Supreme Court unless there is definite proof that a clear error has been committed. In the instant petition a contortion citation is used to allege that the construction of the decision in the *Picard* case by the Second Circuit Court of Appeals as applying to the instant case. It's a far-fetched theory and therefore cannot be cited as clear error. It is inference and has no direct bearing and therefore may be called foreign or hearsay.

11. Only one Circuit has ruled on the question here at issue and therefore according to the rules of the Supreme Court, no writ of certiorari is justified. It is denied that similar articles are not manufactured. See Circulars of the Pulmosan Corp., 276 Johnson St., Brooklyn, N. Y.; Wilson Prod. Inc., Reading, Pa.

12. Regarding disagreements in interpretations between learned experienced judges as to the meaning of the words "flash of genius", it is submitted that that expression is not pertinent in the instant case. Neither the trial court nor the Appeals Court made use of expression in their opinions or findings of fact.

WHEREFORE, your respondent respectfully requests that the writ of certiorari prayed for by petitioner to be directed to the United States Circuit Court of Appeals for the Second Circuit, be denied by this Honorable Court.

Most respectfully submitted,

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Respondent,
Pro se,
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New York, N. Y.

April 27, 1943.